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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,516	11/14/2003	Michael Garfield	200189.00001	9976

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EXAMINER

LEE, RIP A

ART UNIT PAPER NUMBER

1713

DATE MAILED: 01/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,516

Applicant(s)

GARFIELD ET AL.

Examiner

Rip A. Lee

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-19 and 21-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27-29 is/are allowed.
- 6) ☒ Claim(s) 1, 3-7, 13, 14, 18, 19, 25 and 26 is/are rejected.
- 7) ☒ Claim(s) 2, 8-11, 15-17 and 2-24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action follows a response filed on November 14, 2005. Applicants have amended claims 1, 21, 25, 27, and 28. Claim 20 was canceled, and new claim 29 was added. Claims 1-11, 13-19, and 21-29 are pending. The indicated allowability of claims 1, 25, and 26 is withdrawn in view of the newly discovered references, Williams *et al.* (U.S. 4,853,069), Skelley (U.S. 5,610,239), and Gupta (U.S. 4,515,992). Rejections based on the newly cited references follow.

Claim Rejections - 35 USC § 102 / 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 25 and 26 are rejected under 35 U.S.C. 102(b) as being unpatentable over Gupta (U.S. 4,515,992).

Gupta teaches a solution comprising SBS block copolymer and hydrocarbon resin dissolved in about 80 wt % of toluene (example 2). The inventor also states that the solvent may be perchloroethylene or trichloroethylene (col. 5, lines 26 and 27). Therefore, the combinations SBS block copolymer and hydrocarbon resin dissolved in about 80 wt % of perchloroethylene and SBS block copolymer and hydrocarbon resin dissolved in about 80 wt % of trichloroethylene are also taught by the prior art. As such, the subject matter of claims 25 and 26 are fully anticipated by Gupta.

3. Claims 1, 3-7, 13, 14, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams *et al.* (U.S. 4,853,069).

Williams *et al.* discloses a composition comprising a chlorosulfonated polyethylene base resin, tackifying agent, and inert, volatile solvent/diluent viscosity reducing vehicle (claim 1). According to the inventors, the chlorosulfonated polyethylene, which is commercially available as Hypalon 20, is a thermoplastic elastomer (col. 4, line 45). Therefore, this material would qualify as the "rubber composition" of present claim 1. The tackifier component is selected from modified petroleum resins (col. 5, line 53; Picco series from Hercules is an aromatic modified polyterpene[†]). Halogenated, particularly chlorinated, liquid alkanes and aromatics such as perchloroethylene, perchloroethane, chloroform, and chlorobenzene may be conveniently used (col. 6, lines 65-68) as solvent. A preferred solvent is a 50/50 mixture of perchloroethylene and chlorotoluene (col. 7, line 33). The overall composition is a homogeneous blend which is stored until used (col. 8, line 6), and this implies that it can be used as a coating composition; see also col. 8, line 56-58. Table 1 shows a working formulation of the invention comprising 10-100 pw of chlorosulfonated polymer and 10-90 pw of tackifier and solvent/diluent as needed. Carbon black may be added as reinforcing filler, and this imparts a black color to the material, as indicated in Table IV. The reference does not show an example in which modified petroleum resin is used as tackifier, however, one of ordinary skill in the art would have found it obvious to use this material and thereby arrive at the subject matter of the instant claims because such a material is taught by the patent for the same end use, *i.e.*, making adhesives. As such, one would have expected such an embodiment to work with a reasonable expectation of success.

[†] See Graham *et al.* (U.S. 4,654,398) and Poskitt (U.S. 4,042,554).

4. Claims 1, 3-7, 13, 14, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skelley (U.S. 5,610,239) in view of Chu *et al.* (U.S. 5,177,163) or Muse (U.S. 4,011,178).

Skelley teaches an adhesive composition comprising a styrene-butadiene copolymer rubber component. A tackifier component is included in the amount of 0-30 wt %, and one such material is styrene-modified hydrocarbon resin (col. 3, lines 31-33). The patent does not indicate specifically what constitutes "styrene-modified hydrocarbon resin," however, it is maintained that one of ordinary skill in the adhesives art would have found it obvious that this implies C5 hydrocarbon resins. Even if the routineer were uninformed, he need turn to Chu *et al.* or Muse, which teaches that "styrene-modified hydrocarbon resin," referring to modified C5 (piperylene, 3-methyl-1-butene) resins, are common tackifiers for adhesive compositions. Muse teaches that these tackifiers are especially well-suited for styrene-butadiene based adhesives (col. 2, lines 57-64). Thus, one of ordinary skill in the art would have found it obvious to use the resin described in Chu *et al.* or Muse for the same purpose in the invention of Skelley.

Solvent (0-10 wt %) is added to adjust the viscosity of the composition, and suitable solvents include halogenated hydrocarbons such as trichloroethylene, methylene chloride, perchloroethylene, and chloroform (col. 4, lines 29-31 and 36). Pigmented filler (TiO₂, carbon black, zinc white) and pigmented acid acceptors (litharge red, iron oxide) may be used (col. 3, lines 16-18 and 37-39). Although the reference does not show an example or an embodiment containing the three components recited in the instant claims, it is maintained that one of ordinary skill in the art would have found it obvious to select these materials and thereby arrive at the subject matter of the instant claims because the reference teaches that they may be used for the same end use, *i.e.*, making adhesives. As such, one would have expected such an embodiment to work with a reasonable expectation of success.

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5. Claims 2, 8-11, 15-17, and 21-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. None of the cited references teaches or fairly suggests the subject matter of the listed claims.

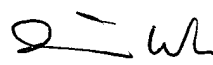
6. Claims 27-29 are allowed. The claims are drawn to a method of coating a wall comprising preparing a solution comprising an aromatically modified C5 hydrocarbon resin, a rubber, pigment, and a non-flammable chlorinated solvent system, wherein the solution has a viscosity of about 6000 cps to about 14,400 cps (77 °F) and about 2000 to about 5600 cps (140 °F). None of the cited references teaches or fairly suggests the subject matter of the listed claims

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached at (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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January 18, 2006


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